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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,693	03/24/2004	Hiroshi Nakata	1052-04	4406

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IP GROUP OF DLA PIPER US LLP  
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PHILADELPHIA, PA 19103

EXAMINER
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ROE, JESSEE RANDALL

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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11/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/807,693

Applicant(s)

NAKATA ET AL.

Examiner

Jessee Roe

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,17,19,21,23,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,17,19,21,23,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 1, 3, 5, 7, 17, 19, 21, 23 and 25-26 are pending wherein claims 2, 4, 6, 8-16, 18, 20, 22 and 24 are canceled and claims 25-26 are new.

### ***Priority***

Applicant cannot rely upon the foreign priority papers because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. MPEP § 201.15.

### ***Status of Previous Rejections***

The previous rejection of claims 1, 3, 5, 7, 17, 19, 21 and 23 under 35 U.S.C. 103(a) as being unpatentable over Toru et al. (JP 2004-84019 A) in view of Tosaka et al. (US 6,110,299) is withdrawn in view of the Applicant's arguments.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 7, 17, 19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ishizaki et al. (US 3,849,209).

Claims 1, 3, 5, 7, 17, 19, 21 and 23 are rejected on the same grounds as stated in the Office Action of 19 March 2007.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable Over Ishizaki et al. (US 3,849,209) as applied to claims 1 and 17 above, and further in view of Unrath (US 3,241,215).

Ishizaki et al. ('209) disclose a hot rolled steel plate and strip having superior low temperature toughness and weldability that would be coiled (col. 2, lines 20-60 and col. 12, lines 12-16). However, Ishizaki et al. ('209) do not specify forming a pipe.

Unrath ('215) discloses utilizing skelp (strip metal) in coil form and welding the strip in order to form pipes for such uses as high pressure lines, boilers, oil well casing and tubing (col. 1, lines 29-49 and col. 2, line 54 - col. 3, line 44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the hot rolled steel plate and strip that would be coiled, as disclosed by Ishizaki et al. ('209), and weld the strip to form pipes, as disclosed by Unrath ('215), in order to use the steel for high pressure lines, boilers, oil well casing and tubing, as disclosed by Unrath (col. 1, lines 29-49 and col. 2, line 54 – col. 3, line 44).

Still regarding claims 25 and 26, the Examiner asserts that the steel of Ishizaki et al. ('209) would be electrically resistant because Ishizaki et al. ('209) disclose substantially the same composition as that of the instant invention. MPEP 2112.01 I.

### ***Response to Arguments***

Applicant's arguments filed 13 August 2007 have been fully considered but are not persuasive.

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a finished hot-rolled steel strip) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, the Applicant primarily argues that Ishizaki et al. ('209) uses steel containing high carbon quantities outside the claimed ranges. In response, the Examiner notes that it would be unfeasible for Ishizaki et al. ('209) to present all possible compositions in the preferred embodiments from the ranges of carbon, 0.005-0.15% C, as in claim 1 of Ishizaki et al. ('209). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. MPEP 2123.

Third, the Applicant primarily argues that it is very likely that the CTOD toughness would not be obtained in Ishizaki et al. ('209). In response, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. Once a prima facie conclusion of obviousness has been established, it is the Applicant's burden to set forth evidence to rebut the prima facie conclusion of obviousness. MPEP 2142.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

ROY KONG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER